

Application Number 09/808,313
Responsive to Office Action mailed May 10, 2005

REMARKS

This amendment is responsive to the Final Office Action dated May 10, 2005. Applicant has amended claims 1, 8, 12, 19, 23, 34 and 39. Claims 1-8, 10-19, 21-31, 33-39, and 41 remain pending.

Claim Rejection Under 35 U.S.C. § 112

In the Final Office Action, the Examiner rejected claim 39 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner stated that the term "substantial" is a relative term that renders the claim indefinite.

Applicant traverses the rejection of 39 under 35 U.S.C. 112. It is well established that the claim term "substantially" does not render claims indefinite. Accordingly, Applicant requests immediate withdrawal of the rejection.

On a number of occasions, the Court of Appeals for the Federal Circuit has specifically addressed the issue of the term "substantially" in relation to 35 U.S.C. 112. Most recently, this specific issue was addressed in *Verve v. Crane Cams, Inc.* (CAFC Nov. 14, 2002). The court in *Verve v. Crane Cams, Inc.*, cited numerous examples of cases holding that the term "substantially" is not an indefinite claim term. In particular, the court in *Verve v. Crane Cams, Inc.*, stated:

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. §112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed. Cir. 1988) the court explained that usages such as "substantially equal" and "closely approximate" may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed. Cir. 2001) that "like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,'" quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed. Cir. 1995).

Moreover, the court in *Verve v. Crane Cams, Inc.*, continued by stating:

Application Number 09/808,313
Responsive to Office Action mailed May 10, 2005

It is well established that when the term "substantially" serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite.

The instant case is a classic example of use of the term "substantially" to describe the subject matter so that its scope would be understood by persons in the field of the invention, and use of the term "substantially" is necessary to provide the Applicant with the benefit of his invention. Applicant requests immediate withdrawal of all rejections under 35 U.S.C. 112.

Claim Rejection Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 1-3, 5-8, 10-14, 16-19, 21-25, 27-30, 33-35, 37, 39 and 41 under 35 U.S.C. 103(a) as being unpatentable over Paul (US 6,687,817) in view of Kusters et al. (US 6,681,310). In addition, the Examiner rejected claims 4, 15, 26 and 36 under 35 U.S.C. 103(a) as being unpatentable over Paul and Kusters et al. in view of Stallmo et al. (US 5,875,456). The Examiner rejected claims 31 and 38 under 35 U.S.C. 103(a) as being unpatentable over Paul and Kusters et al. in view of Wang et al. (US 6,826,613).

Applicant respectfully traverses the rejections to the extent such rejections may be considered applicable to the claims as amended. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Applicant has amended independent claims 1, 12, 23, 34 and 39 to include certain elements from the currently pending dependent claims. Consequently, no new issues have been raised by this amendment, and no new search is required. Furthermore, as discussed in detail below, Applicant's amended claims 1-8, 10-19, 21-31, 33-39, and 41 are in a condition for allowance. Accordingly, this amendment complies with 37 CFR 1.116, and Applicant requests entry of this amendment.

For example, Applicant has amended claim 1 to include elements from dependent claim 8 to require intercepting a multicast message from a remote storage device to a computer, wherein the message requests a network address for the remote storage device from the computer. In this manner, Applicant has amended claim 1 to clarify that the multicast message is a request for a network address, and that the request is intercepted. These requirements are substantially

Application Number 09/808,313

Responsive to Office Action mailed May 10, 2005

similar to those of previously pending claim 8, which required intercepting a request from the remote storage device for an Internet Protocol (IP) address.

In reference to these elements, the Examiner stated that Paul teaches intercepting a request from a remote storage device for an Internet Protocol (IP) address (col. 3, lines 12-46) (emphasis added). However, this interpretation of Paul is incorrect. Paul describes a system in which a new device 320 sends a multicast request to communicate with a configuration computer 300. Paul makes clear that the new device 320 "will repeatedly send the configuration request 330 until the configuration computer 300 response" (col. 3, ll. 44-45). Thus, Paul describes a system in which two devices utilize multicast communication to communicate with each other and for the intended purposes of requesting and providing configuration data.

In contrast, Applicant's claim 1, as amended to include elements of dependent claim 8, requires intercepting a multicast message from a remote storage device to a computer, wherein the message requests one of the network addresses for the remote storage device from the computer. The Merriam-Webster's Dictionary of Law defines the term "intercept" defined as "to receive (a communication or signal) directed elsewhere, usually secretly."¹

In a multicast communication there is typically a sender and set of one or more intended receiving devices, although the actual network addresses of the recipients are not specified. With respect to Paul, the configuration computer 300 is the intended destination for the configuration request. Thus, new device 320 and configuration computer 300 communicate with each other via multicast communications. In other words, the multicast communication from the devices of the Paul system are intended for each other. Paul does not teach or even suggest intercepting a multicast message from a remote storage device to a computer.

To further illustrate this point, Applicant notes that Paul provides no teaching or suggestion of intercepting a multicast request and utilizing that request for some other, non-intended purpose that is unrelated to the request. For example, claim 1 requires intercepting a request for a network address, and then performing functions unrelated to the actual request, i.e., the automatic incorporation of storage capacity into a logical storage volume. In contrast, Paul teaches a new device 320 that outputs a multicast request for configuration data and receives that configuration data from a configuration computer 300. Thus, in Paul, configuration computer

¹ Merriam-Webster's Dictionary of Law, © 1996 Merriam-Webster, Inc.

Application Number 09/808,313
Responsive to Office Action mailed May 10, 2005

300 (the intended recipient) receives and replies to the multicast request to address the purpose of the request, i.e., to receive configuration data. This is quite different from Applicant's amended claims.

None of the other cited references overcome these deficiencies. In particular, none of the secondary references provide any teaching that would have led a person of ordinary skill in the art to modify the techniques of Paul to cause interception of a multicast message. For at least these reasons, Paul in view of the other cited references fails to teach or suggest detecting the attachment of the remote storage device to a network in response to the intercepted multicast message. Similarly, Paul in view of the other cited references fails to teach or suggest performing a function unrelated to that intercepted multicast request, i.e., automatically incorporating storage capacity of the detected remote storage device into a logical storage volume, as required by claim 1.

For these or other reasons, Paul, in view of the cited references, fails to teach or suggest the elements of independent claims 12, 23, 34 and 39, which have been amended in a manner similar to claim 1.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 09-0069. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

7/11/05

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